

REMARKS/ARGUMENTS

All claims stand rejected.

The Rejections

Claims 29-34, 36 and 45-47 were rejected under 35 USC §102 as being anticipated by Diehl et al., U.S. Patent No. 6,317,544 (“Diehl”).

Claims 1-4, 6-9, 11, 15 and 28 were rejected under 35 USC §103 over Diehl in view of Fishbine et al., U.S. Patent No. 5,222,152 (“Fishbine 152”), which incorporates by reference Fishbine et al., U.S. Patent No. 4,811,414 (“Fishbine 414”).

Claim 5 was rejected under 35 USC §103 over Diehl in view of Fishbine 152 further in view of Arndt et al., U.S. Patent No. 4,917,987 (“Arndt”).

Claim 10 was rejected under 35 USC §103 over Diehl in view of Fishbine 152 further in view of Fuller et al., U.S. Patent No. 4,843,377 (“Fuller”).

Claims 1, 11-13 and 39 were rejected under 35 USC §103 over Diehl in view of Fishbine et al., U.S. Patent No. 5,467,403 (“Fishbine 403”), which incorporates by reference Fishbine et al., U.S. Patent No. 4,811,414 (“Fishbine 414”).

Claim 14 was rejected under 35 USC §103 over Diehl in view of Fishbine 152 and further in view of Fan, U.S. Patent 6,552,682 (“Fan”).

Claim 23 was rejected under 35 USC §103 over Diehl in view of Fishbine 403 and further in view of Fan.

Claims 35 and 40-43 were rejected under 35 USC §103 over Diehl in view of Arndt.

Claims 37 and 38 were rejected under 35 USC §103 over Diehl in view of Fujieda U.S. Patent No. 6,011,860 (“Fujieda”).

Claims 16-22, 24-27 and 48 are rejected under 35 USC §103 over Diehl in view of Fishbine 403, which incorporates by reference Fishbine 414 further in view of SFS 2000.

The Claims as Amended

Applicants maintain the claims as previously presented are patentable over the cited art for at least the reasons given in previous amendments, including that none of the cited references permit the capture of a fingerprint image at a portable handheld device while the device is being handheld. However, to focus and advance prosecution, Applicants have amended independent claims 1, 31, 36,

42, 45 and 47 to recite features described in claims 16 and 48. These amendments are made solely to advance prosecution and without prejudice to pursuing the claims as originally presented in further prosecution or applications.

Claim 16

Claim 16 is directed to a portable apparatus for identification and verification of a fingerprint. It recites, in part,

a housing including a handle portion having a distal end and a proximal end and a user interface portion at the distal end of the handle portion, wherein the handle portion and user interface portion are configured to allow the handle portion to be held by a single hand of an operator and the apparatus operated via the user interface using the same hand during image capture of the fingerprint; [and]

a finger-receiving surface located at the distal end of the handle portion for receiving images of a fingerprint of a subject while the apparatus is being handheld by the operator...

The apparatus is configured such an operator (e.g., a police officer) can hold the apparatus with a single hand while capturing the fingerprint of a subject (e.g., a criminal suspect). This leaves the other hand of the operator free to protect him or herself while the print is captured.

The Art

Diehl

Diehl et al. discloses a lunchbox computer 70 that includes several parts that move independently and require both hands and a stable surface to use. (See Fig. 5). Specifically, a front panel 85 of the lunchbox computer folds down from an upright and locked position to reveal a display screen 95 and a keyboard 80. Likewise, a back panel 90 folds down to permit access to a radio telephone 40, a color camera 55, and a fingerprint scanner 60. The lunchbox computer must be positioned upon a surface to allow the front and back panels to be folded down. The use of the lunchbox computer and keyboard requires both hands, and the lunchbox computer must be on a stable surface in use. The system also requires an operator to position an individual's finger on the fingerprint scanner. (See Col. 11, lines 10-26).

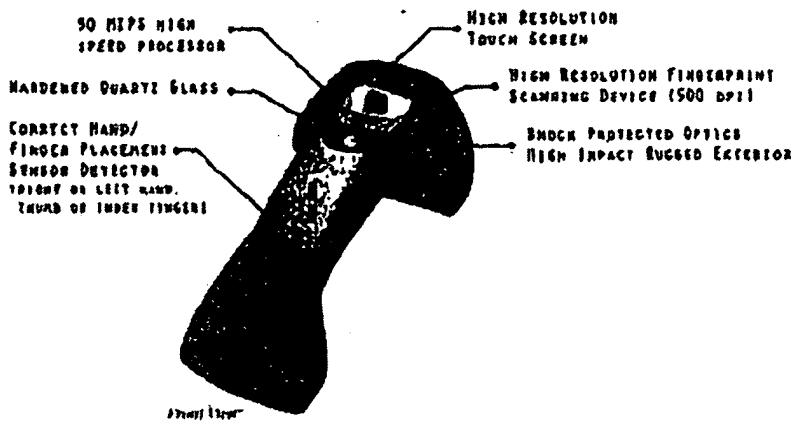
Fishbine '403

Fishbine et al. '403 discloses an image collection unit 10 having a writing surface 58 and a keypad 25. A user interface surface 59 contains the keypad and a display 26. The writing surface includes a clip (not shown) for clipping a tablet of citations to the writing surface. The image collection unit is shaped like a relatively thick clipboard. The image collection unit also includes a finger receiving surface 40 of a fingerprint scanner 12 in its front end surface 56. (See Col. 4, lines 38-58). The unit must be on a stable surface so that both hands can be used in its operation.

SFS 2000

The SFS 2000TM device is not capable of being used as a portable handheld device in which an operator of the device holds it and presents it to a subject to capture the subject's fingerprint. Rather, the SFS 2000TM device is configured to be placed on a flat surface such that a subject can place his hand on the top surface of the device with the subject's finger positioned on the imaging surface of the device.

This is clear from the attached brochure of the SFS 2000TM (cited in the IDS filed on October 11, 2007). Referring to the image on first page of the brochure, inserted below, the subject's hand is placed on the top surface of the device near the indicator line labeled: "Correct Hand / Finger Placement Sensor Detector". The fingerprint imaging surface on which the tip of the finger rests is labeled: "Hardened Quartz Glass." "Sensors on the side the SFS 2000TM detect whether the correct hand and finger are being used, and the design also helps ensure correct finger placement." (See the second page of the brochure). That is, these sensors are used to determine if the finger of the subject's right or left hand is being imaged.



Note that the long central portion of the device is where the subject places his or her hand or finger. The device does not contemplate or allow an operator to hold the apparatus while the subject is fingerprinted. Rather, the device is configured to be placed on a flat surface such that a subject can place his hand on the top surface of the device with the subject's finger positioned on the imaging surface of the device,

Applicants' Invention Is Not Anticipated Nor Would It Have Been Obvious

The devices of Diehl et al., Fishbine et al. '403, and the SFS 2000 do not permit the capture of a fingerprint image at a portable handheld device while the device is being handheld. Thus, these references do not anticipate Applicants' claimed invention, nor would they have rendered Applicants' claimed invention obvious.

As described in previous Amendments, Diehl et al.'s device has several parts that move independently and require both hands and a stable surface to use. As described in Diehl et al., the front panel 85 folds down from an upright and locked position that covers the display screen 95 to a downward position which reveals the keyboard 80. Likewise, the back panel 90 folds down to permit user access to the radio telephone 40 and the fingerprint scanner 60. (Col. 11, lines 17-22). Diehl et al.'s lunchbox computer must be positioned on a flat surface to allow the front and back panels to be folded down. Diehl et al.'s device also requires an operator to position an individual's finger on the fingerprint scanner. The initiation of "search and enroll" brings up a screen that

prompts the operator to place an individual's left index finger on the fingerprint scanner. The screen then prompts the operator to place the individual's right index finger on the fingerprint scanner. (Col. 3, lines 27-31). Furthermore, the use of the keyboard requires both hands.

Fishbine et al. '403 was cited as an example of a device that has "an ergonomic handle formed thereon that provides for one hand operation and command . . ." However, there is no disclosure in Fishbine et al. '403 that a fingerprint image may be captured by that device while it is being handheld. As noted, the top surface 54 of the image collection unit 10 includes the writing surface 58 and the user interface surface 59. The user interface surface contains the display 26 and the keypad 25. The writing surface 58 includes the clip for clipping a tablet of citations to the writing surface. The front end surface 56 includes the finger receiving surface 40 of the fingerprint scanner 12. Operation of the image collection unit 10 requires that it be set upon a stable surface, such as a hood of a patrol car, so that both hands can be used in its operation.

The SFS 2000 is not configured to allow the handle portion to be held by a single hand of an operator and the apparatus operated via the user interface using the same hand during image capture of the fingerprint.

Finally, as noted by the Examiner neither Diehl nor Fishbine '404 describe a housing having handle portion to be held by a single hand of an operator and the apparatus operated via the user interface using the same hand during image capture of the fingerprint. The SFS 2000 is relied on for this limitation. However, as shown above, what the Examiner appears to refer to as the "handle portion" of the SFS 2000 is in fact where the subject places his hand or finger. There is no place for an operator to hold the apparatus; rather the apparatus is placed on a surface during use.

Accordingly, Applicants submit that claim 16 and its dependent claims are patentable over the cited references at least because the references, either alone or in combination, do not provide a handle portion to be held by a single hand of an operator and the apparatus operated via the user interface using the same hand during image capture of the fingerprint. Independent claims 1, 31, 36, 42, 45, 47 and 48 as well as their dependent claims for at least this reason.

Conclusion

In view of the foregoing, it is submitted that all the claims are now in condition for allowance. Accordingly, allowance of the claims at the earliest possible date is requested.

If prosecution of this application can be assisted by telephone, the Examiner is requested to call Applicants' undersigned attorney at (510) 267-4106.

Please apply any other charges or credits to deposit account number 504480 (Order No. IDTXP044).

Respectfully submitted,
Weaver Austin Villeneuve & Sampson LLP

/Denise Bergin/

Denise Bergin
Reg. No. 50,581

P.O. Box 70250
Oakland, CA 94612-0250